

### **Remarks**

With the entry of the present Amendment, claims 2-9 will be pending in this patent application. By the present Amendment, claim 1 has been canceled, claim 2 has been amended and claims 3-9 have been added.

#### *Substitute Specification Approved*

Applicant notes with appreciation the Examiner's approval of the substitute specification filed by Applicant on November 22, 2004.

#### *Examiner's Objections to Specification*

In the outstanding Office Action, the Examiner objected to the specification under 37 CFR § 1.71 as being unclear and non-enabling. In particular, the Examiner identified disclosure on page 5 of the substitute specification as being confusing and not understood. An amendment to the first paragraph beginning on page 5 of the specification is introduced in this paper which, Applicant submits, obviates ambiguities and/or confusion in that paragraph and provides a clear disclosure of the positions and orientations of elements and attributes of the club head. The foregoing amendments are fully supported by the original disclosure in this application and do not introduce new matter.

#### *§ 112, First Paragraph, Rejection*

The Examiner rejected claims 1 and 2 under 35 USC § 112, first paragraph, as failing to comply with the enabling requirement. Applicant traverses this rejection insofar as it might be deemed applicable to any of claims 2-9 as now presented.

The Examiner held that the subject matter recited in the claim was not satisfactorily disclosed in the specification and questioned "how a shaft angle is arranged in a vertical plane and a face angle is set to zero." Applicant submits that this rejection is obviated by the amendments to the specification noted above. Specifically, in the amendments to the specification, a zero degree face angle is clearly defined. Claim 3 has been carefully drafted

using language that is consistent with the language now used in the specification. No new matter has been introduced by any of these amendments.

*Prior Art Rejection I*

The Examiner rejected claim 1 under 35 USC § 103(a) as being unpatentable over US 6776723 B2 (Bliss et al.) in view of US 5348777 (Oonuki et al.). Applicant traverses this rejection insofar as it might be deemed applicable to any of claims 2-9 as now presented.

Bliss et al. discloses a golf club head wherein weight members (226, 228 in Fig. 2) are positioned within the club head so as to lower the center of gravity of the club head and adjust the center of gravity toward and away from the club face as a function of the loft angle of the club head. As shown in Fig. 2 and described in column 3, lines 35-45, the orientation of the club face is determined through the use of a horizontal line tangent to the club face at its center.

The Examiner's commentary on the Bliss et al. disclosure (in the paragraph bridging pages 3-4 of the Office Action) is confusing and at odds with what is actually disclosed in Bliss et al. For, example, what does the Examiner mean by 'a tangent line parallel to line "h"'? And, on what basis does the Examiner determine the position of the intersection of this "tangent line" with a line dropped from the sweet spot? Contrary to the assertions of the Examiner, the Bliss et al. disclosure says nothing about the location of a point at which a line dropped from the sweet spot on the club face intersects the horizontal line that is tangent to the club face at its center.

The Examiner acknowledges that Bliss et al. does not disclose a club head having the claimed shortest distance between the shaft axis and the center of gravity G. As a remedy for this deficiency, the Examiner proposes a modification of the Bliss et al. club head in which this distance is 47-48 mm, based on the incidental disclosure in Oonuki et al. of a distance of 20-50 mm separating the shaft axis and the center of gravity of the club head.

The problem with the combination of teachings proposed by the Examiner is that the modification of the Bliss et al. club head would be in conflict with the explicit teachings of Bliss et al., where the position of the center of gravity is adjusted based on the objective of lowering

the center of gravity and adjusting the position of the center of gravity as a function of club face loft angle. Certainly there is no disclosure in either Bliss et al. or Oonuki et al. suggesting that the modification of the Bliss et al. club head proposed by the Examiner would be advantageous.

Even if the teachings of Bliss et al. and Oonuki et al. were combined as proposed by the Examiner, the resulting club head would not meet the attributes of the club head recited in independent claim 3. There are, for example, no teachings in Bliss et al. or Oonuki et al. that could satisfy the claimed requirements for the location of point T and the moments of inertia about two different axes.

The club head defined by claim 3 exhibits superior properties, as described in Applicant's specification and substantiated by the results of tests reported in the specification. The claimed club head is not met - or made obvious - by the prior art applied by the Examiner. In view of the foregoing observations, Applicant respectfully submits that Bliss et al. and Oonuki et al. cannot properly serve as a basis for rejecting claim 3 or dependent claims 2 and 4-9 under 35 USC § 103.

#### *Prior Art Rejection II*

The Examiner rejected claim 2 under 35 USC § 103(a) as being unpatentable over Bliss in view of US 6623377 B2 (Evans). Applicant traverses this rejection insofar as it might be deemed applicable to any of claims 2-9 as now presented.

The Examiner relies on Evans et al. for a disclosure of a club head having a volume of more than 300 cm<sup>3</sup>.

Without acquiescing in the combination of the Bliss et al. and Evans et al. disclosures proposed by the Examiner, Applicant observes that Evans et al. offers no disclosure that can remedy the deficiencies of Bliss et al. vis-à-vis the requirements of Applicant's claims, as noted above. Consequently, Bliss et al. and Evans et al. cannot properly serve as a basis for rejecting claim 3 or dependent claims 2 and 4-9 under 35 USC § 103.

*Allowability of Dependent Claims*

For reasons presented above, Applicant submits that independent claim 3 is allowable over the prior art of record. The allowability of claim 3 inheres, of course, in dependent claims 2 and 4-9. The dependent claims are also allowable because of additional departures from the prior art of record that these claim recite. For example, the prior art offers no disclosure for the curvature of the face bulge and face roll recited in claims 4-6, no disclosure for the thickness recited in claim 8 and no disclosure for the location of point T recited in claim 9.

*Conclusion*

In view of the amendments and comments made in this paper, Applicant respectfully requests that the objection and rejections stated in the outstanding Office Action be withdrawn and that the Examiner issue a Notice of Allowance in this patent application.

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If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32, 874, at the telephone number provided below, so that a resolution of these matters can be effected.

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Respectfully submitted,

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